

REMARKS

The Applicant thanks the Examiner for the careful review of the specification. Reconsideration of the application is respectfully requested based on the above amendments and these remarks.

Applicant respectfully requests an initialed copy of the Form PTO-1449 attached to the Information Disclosure Statement filed on March 3, 2003, or if the Information Disclosure Statement has not already been considered, prompt consideration of the same. In addition, Applicant respectfully requests that Examiner acknowledge the claim to domestic priority under 35 U.S.C. § 120, in addition to the claim under § 119, since a specific reference was included in the first sentence of the specification.

I. Status of the Claims

Claims 1–23 are pending in the application. Claims 1, 10, 19, 21 and 23 are independent claims. Claims 2–9, and 20 depend, directly or indirectly, from claim 1; claims 11–19 depend, directly or indirectly, from claim 10; and claim 22 depends from claim 21. Claim 24 is added in this amendment, and it depends from claim 1.

New claim 24 is supported in at least paragraph 18 of the specification. No new matter is added.

Claims 1–22 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. Claims 1–22 were also rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 4,438,953 (“Timme”).

II. Restriction Requirement

The invention is subject to a restriction requirement under 35 U.S.C. § 121. Two groups were identified:

- I. Claims 1–22 — drawn to a pipe connection and classified in class 285, subclass 93
- II. Claim 23 — drawn to a method of determining connection wear and classified in class 29, subclass 407.05.

The Examiner constructively elected Group I, and the applicant confirms the election of Group I. Accordingly, claim 23 is cancelled with this amendment.

III. Rejections Under § 112, ¶ 2

Claims 1–22 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. Specifically, the Examiner believed that the phrase “complimentary internal and external threads” in claim 1 is unclear, the phrase “the complimentary internal and external threads” in claim 10 lacks antecedent basis, and the phrase “the other of the shoulder of the pin member and the shoulder of the box member” in claim 21 lacks positive antecedent basis. Claims 1 and 10, as well as claims 19 and 21, which also include the phrase, have been amended to more clearly recite the invention. This amendment has no effect on the scope of the claims. Accordingly, withdrawal of this rejection is respectfully requested.

Claim 21 is amended to correct the lack of antecedent basis. Accordingly, withdrawal of this rejection is respectfully requested.

IV. Rejections under § 102

Claims 1–22 were rejected under 35 U.S.C. § 102 as being anticipated by Timme. To the extent this rejection applies to the amended claims, the rejection is respectfully traversed because Timme does not disclose all of the limitations in the independent claims.

Independent claims 1, 10, and 21 all include the limitation of “a wear indicator that extends from” a shoulder of the connection. This limitation is not disclosed in Timme.

Timme discloses a benchmark (27 in FIG. 5) and a shoulder (17 in FIG. 5). The distance between the benchmark and the shoulder serves to indicate if the shoulder has been redressed and whether the shoulder is able to provide sufficient compression such that the tool joint is suitable for further use. Col. 2, ll. 55-66.

The Applicant notes that the Examiner appears to have misunderstood the prior art figure. The Examiner has shaded the shoulder (17 in Figure 5 of Timme) in the prior art and called it a "wear indicator." To the extent that that the shoulder is a wear indicator, it does not correspond to the claimed invention because it does not "extend from" the shoulder, as required by the independent claims.


Timme does not disclose all of the limitation in the claimed invention. Thus, independent claims 1, 10, 21, and 23 are patentable over Timme. Dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicant believes this reply to be responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09432/168002).

Respectfully submitted,

Date: 2/19/04

 #45,079
Jonathan P. Osha, Reg. No. 33,986
ROSENTHAL & OSHA L.L.P.
1221 McKinney Street, Suite 2800
Houston, Texas 77010
Telephone: (713) 228-8600
Facsimile: (713) 228-8778